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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
11051ROUS01U (NORT10-00088)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name Kathy Cedor

Application Number	Filed
09/695,108	October 25, 2000

First Named Inventor: Robert S. Morley

Art Unit	Examiner
2144	T.T. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 38,717.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Robert D McCutcheon
Signature

Robert D. McCutcheon
Typed or printed name

(972) 628-3600
Telephone number

November 14, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

DOCKET NO. 11051ROUS01U (NORT10-00088) **PATENT**
Customer No. 33000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Robert S. Morley, et al.
Serial No.	:	09/695,108
Filed	:	October 25, 2000
For	:	SERVICE ENABLING TECHNOLOGY
Group No.	:	2144
Examiner	:	T.T. Nguyen

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

STATUS OF THE CLAIMS

Claims 1-38 and 44-47 are pending in the present application.

Claims 1-38 and 44-47 have been rejected.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-4, 6-9, 11-15, 17-38, 44 and 45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Carter, et al. (US 6,266,782). The Applicants respectfully submit that the Carter reference does not teach each and every limitation of the claimed invention, and therefore the Examiner has failed to establish a *prima facie* case of anticipation.

The Applicants argued on pages 15-18 of the Response to Final Office Action, filed September 13, 2005, that three limitations of the claims rejected under § 102 that are not disclosed in the Carter reference. The absence of the three limitations was also argued on pages 16-17 of the Applicants' Amendment and Response to Office Action, filed December 3, 2004. The lack of any one of these limitations in Carter is sufficient to render incomplete the case of anticipation asserted by the Examiner.

The Applicants' three arguments are that (1) Figure 4 and the associated passage relied upon by the Examiner describe two H.323 nodes sharing an application using the T.120 protocol, rather than teaching logically associating a selection of at least one device component in an aggregate logical device, as asserted by the Examiner, (2) that Figure 4 of Carter presents a logical model illustrative of the Carter invention, rather than teaching a method including a step of maintaining a logical model, and (3) Figure 2 of Carter and the associated text relied upon by the Examiner teach a software layer interpreting the H.225 communications protocol, rather than describing a component device being represented to a data network service as an aggregate logical device.

In the Advisory Action, mailed October 4, 2005, the Examiner responded only to the first of the Applicants' arguments. On the Continuation Sheet of the Advisory Action, the Examiner points out that Carter describes computer devices and that the Applicants' specification refers to a

workstation as an "aggregate device." However, the Examiner does not indicate where Carter teaches logically associating device components in an aggregate logical device, as recited in the Applicants' claims.

The Examiner has made no response in any correspondence to the Applicants' arguments (2) and (3). The panel is referred to pages 16-17 of the Applicants' Amendment and Response to Office Action, filed December 3, 2004, and pages 16-18 of the Response to Final Office Action, filed September 13, 2005, for a more complete exposition of those arguments, if necessary. The Applicants await some explanation of how the use of a logical model to illustrate an inband protocol correction method discloses the maintenance of a logical model of an aggregate logical device as a step in a method of providing device control of a device component. The Applicants also await a clarification of the Examiner's position that Carter's description of software enabling the communication of two client devices using the H.323 protocol teaches representing device components to a data network service as an aggregate logical device.

REJECTION UNDER 35 U.S.C. § 103

Claims 5, 10, 16, 46 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter in view of Marchetti et al. (US 6,618,398). The Applicants respectfully submit that the Marchetti reference is unavailable as prior art under section 103(a) and the Office Action fails to establish a *prima facie* case of obviousness.

The present application is owned by Nortel Networks Limited, as evidenced by documents recorded at Reel 011348, Frame 0695 (assignment from the inventors to Nortel Networks Limited). The cited reference, US 6,618,398, shows Nortel Networks Limited as the assignee. Therefore, the

present application and the cited reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. As such, the Marchetti reference is unavailable as prior art under section 103(a).

This ground of traversal was presented on pages 17-18 of the Applicants' Amendment and Response to Office Action, filed December 3, 2004, but the Examiner maintained the rejection in the final Office Action, mailed July 13, 2005, without explaining why Marchetti was still considered prior art under section 103(a). The argument was made again on pages 18-19 of the Response to Final Office Action, filed September 13, 2005, but the Advisory Action, too, provided no explanation for why Claims 5, 10, 16, 46 and 47 were not, as a result, in condition for allowance.

CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining Claims in the Application are in condition for allowance, and respectfully request allowance of the Claims. The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

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